

REMARKS

Status of the Claims

Claims 1, 3-5, 7-9 and 11 are still pending. No amendments have been made.

35 U.S.C. 103(a) rejections

- (1) Claims 1, 3, 5, 7-9 and 11 were rejected as being obvious over Schreiber et al. (WO 98/17232 - now U.S. Patent 6,613,338) in view of Dupuis et al. (U.S. Patent 6,338,858).
- (2) Claim 4 was rejected over Schreiber et al. and Dupuis et al. further in view of Yoneyama (U.S. Patent 5,015,469).

Response to Examiner's Arguments**All Differences Not Addressed**

The Examiner's office action did not comment on the difference in weight ranges between Schreiber and the applicants' invention. Assuming the applicants' previous arguments overcame the basis for the examiner's previous rejection, there is no basis for a holding of obviousness as MPEP 2143.03 states that "To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art." (see also *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)).

As a Whole Considerations

The Examiner misinterpreted the applicants' previous arguments as they were not directed toward a process of making but towards asking why and how one of ordinary skill in the art would modify the primary reference in order to arrive at the applicants' claimed invention. It is well known that the *Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness* (see MPEP 2142) and does not meet her burden for establishing a *prima facie* case of obviousness simply by finding all the requisite elements of the applicants' invention in the prior art. As stated in *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998):

"Virtually all [inventions] are combinations of old elements...Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'" *Sensotronics, Inc. v. Aerosonic Corp.*, 81 F.3d 1568, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996)." *Rouffet*, 149 F.3d at 1357, 47 USPQ2d 1457 (emphasis added).

Both the claimed invention and the references must be considered as a whole. *see MPEP 2141 - Basic Considerations Which Apply to Obviousness Rejections*. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ***Knowledge of the applicant's disclosure must be put aside in reaching this determination. see MPEP 2142 (emphasis added).***

The question for rejections (1) and (2) above is what would have been obvious to one of ordinary skill in the art at the time the invention was made when that skilled artisan has been presented with the above cited references but has not been presented with a copy of the applicants specification and claims to act as a guidepost. Schreiber in view of Dupuis can be characterized as follows:

Schreiber (abstract)	Dupuis (abstract)
<p>Lipsticks, antiacne sticks, sunscreen sticks and eyeshadow sticks, with a high water content, characterized in that they comprise:</p> <p>(a) a lipid phase, which comprises (a1) at least one oil component (a2) at least one wax component (a3) optionally other substances soluble or dispersible in the lipid phase,</p> <p>(b) an aqueous phase, which comprises (b1) from 30 to 85% by weight of water, based on the total weight of the stick composition and (b2) if desired, substances soluble or dispersible in water,</p> <p>(c) at least one active ingredient or several chosen from the active ingredients known for lipsticks, antiacne sticks, sunscreen sticks and eyeshadow sticks,</p> <p>(d) a W/O emulsifier or a mixture of two or more W/O emulsifiers,</p> <p>(e) one or more stabilizers, chosen from the group of substances of the general structure A-B-A', where A and A' are identical or different hydrophobic organic radicals, and B is a hydrophilic group,</p> <p>(f) if desired, further surface-active substances as coemulsifiers, and also, if desired, stabilizers and further customary cosmetic and/or pharmaceutical auxiliaries, active ingredients and/or additives.</p>	<p>An aqueous solid topical composition comprising a matrix, i.e., an aqueous solid matrix, having the appearance of a gel and possessing the following rheological profile:</p> <p>an initial viscosity at rest V_0 sufficient to form a solid composition, preferably ranging from 50,000 to 1,000,000 Pa.s, said viscosity V_0 being stable up to a shear strain C_1, a viscosity V_2 after shear at a strain C_2 for which the ratio V_0/V_2 is greater than or equal to 1000:1, the difference C_2-C_1 being less than or equal to 1000 Pa,</p> <p>and which may be useful as a make-up, styling, body hygiene or care composition.</p>

Examiner stated that "the motivation to add the old and well-known cationic polymers of Dupuis to the Schreiber composition would have been obvious because both prior art compositions are W/O stick emulsions such as lipsticks, and that it is well known to use the cationic polymers for conditioning effects." However, this statement is founded on two erroneous presumptions.

First, the Examiner assumes that all stick emulsions are created equal (and presumably that each of the elements are interchangeable) but there is no factual basis for this assumption when viewing the differences in formulation between Schreiber and Dupuis (by way of analogy, a chocolate cake and lasagna could both be considered to be food products, but without any direction or guidance, one could not substitute or add an ingredient of one product into the ingredient of another product) and one of ordinary skill in the art would not presume that all elements of their respective inventions are interchangeable.

Second, as the Dupuis reference is being used for the teaching of cationic polymers, this element of Dupuis is not a required part of their invention and is merely part on vast array of other optional ingredients which includes fragrances, dyes, odor absorbers, stabilizers, screening agents, antioxidants, chelating agents, antiperspirants, bactericidal substances, hair care agents, fixing materials, sheen reinforcers, hair dyes, fillers and gelling agents (see col. 5, line 66 thru col. 10, line 16). Even for the fixing materials itself, cationic polymers are but a small species of the genus of fixing materials (see col. 8, lines 63 thru col. 8, line 20). This is the basis for the applicants' assertion that there is virtually infinite number of possible permutations for Dupuis' invention and there has been no reason offered by the Examiner why one of ordinary skill in the art would be directed to a cationic polymer when they do not have the applicants' disclosure and claims before them to act as a guidepost. Again it is noted that the initial burden of factually supporting any *prima facie* conclusion of obviousness resides with the Examiner; an assertion or opinion offered by the Examiner does not constitute factual support.

As such, the rejection is based on picking and choosing of elements to the exclusion of consideration of the inventions as a whole as is precluded by *In re Rouffet* without special insight which directs one of ordinary skill in the art to select the necessary element for combination. However, "Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998). There must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources, to select particular elements, and to

combine them as combined by the inventor. See *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 665, 57 USPQ2d 1161, 1167 (Fed. Cir. 2000); *ATD Corp.*, 159 F.3d at 545, 48 USPQ2d at 1329; *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994) ("When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination."). *Crown Operations Int'l., Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 1376, 62 USPQ2d 1917, 1922 (Fed. Cir. 2002).

In the interest of brevity, the combination of the Yoneyama reference suffers from the same deficiencies as the combination of Schreiber and Dupuis which will be further explored in the Appeal Brief should one become necessary.

With regard to the Examiner's response to applicants *In re McLaughlin* arguments, it appears there was a misinterpretation of the applicants arguments. The applicants were not arguing that the Schreiber, Dupuis and Yoneyama references were ineligible for use as prior art because of their publication dates. The point of the argument (and the arguments made above) is that the references used must be viewed in light of what one of ordinary skill in the art would have found obvious at the time the invention was made without having the applicants specification and claims as a guidepost. The facts of the *McLaughlin* case dealt with an invention which had far fewer permutations than is possible in the present application and it was not necessary to use the specification and claims as a guidepost in light of the prior art cited in the rejection. Therefore, the Examiner's use of *McLaughlin* in the previous office action was misplaced especially in light of MPEP 2144.04 which states that "...if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court." (a copy of *In re McLaughlin* is included with this response).

Lastly, the applicants note that the initial burden of factually supporting any *prima facie* conclusion of obviousness resides with the Examiner. The applicants hold that this burden has never been met, however, the applicants have also shown that the basis for the Examiner's position to select the requisite element from Dupuis and Yoneyama requires a selection from a virtually infinite number of permutations. As such, the Examiner has never provided additional factual support which allows for this type of selection.

Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone

number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,

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Attachment: Copy of *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

CERTIFICATE OF FACSIMILE TRANSMISSION
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I hereby certify that the foregoing Amendment under 37 CFR § 1.116 (9 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 27 April 2004

By: Agata Glinska
Agata Glinska

LEXSEE 170 USPQ 209

IN RE GERALD MCLAUGHLIN

No. 8474

United States Court of Customs and Patent Appeals

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Oral argument March 3, 1971

June 24, 1971

PRIOR HISTORY: [***1]

Appeal from Patent Office, Serial No. 566,701

DISPOSITION:

Affirmed.

LexisNexis (TM) HEADNOTES - Core Concepts:

COUNSEL:

Norman Lettvin, attorney of record, for appellant.

S. Wm. Cochran for the Commissioner of Patents *R. V. Lupo*, of counsel.

OPINIONBY:

BALDWIN

OPINION: [**1393]

[*1310] Before RICH, ALMOND, BALDWIN, LANE, Associate Judges, and RE, Judge, sitting by designation

BALDWIN, Judge, delivered the opinion of the court.

McLaughlin has appealed from the decision of the Patent Office Board of Appeals sustaining the rejection of claims 13, 14 and 15 in his application n1 as unpatentable under 35 USC 103 in view of the prior art. One claim has been held allowable.

n1 Serial No. 566,701, filed July 5, 1966, for "Compartment Arrangement for Railway Cars."

The Invention

The subject matter of the claims on appeal may be characterized as an improved construction arrangement for railroad "boxcars" which [*1311] are adapted for carrying "unitized" cargo. The latter term is defined by appellant as "cargo that is loaded upon a cargo-handling platform (such as a pallet or slip sheet) of a pre-selected size, and which is arranged for transfer between stations by devices such as fork-lift trucks." [***2]

Appellant states that prior art arrangements, having the doorways located substantially centrally in the opposed sidewalls, leave the center of the car unsuitable for holding additional pallets securely because side filler panels cannot be placed over the doorways without inconveniencing loading and unloading.

The present invention, as represented in Figure 2 of the application, which we reproduce below along with

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Figure 3, is alleged to permit a larger volume of freight to be conveniently loaded in a car with the same overall dimensions.

[Graphic omitted. See illustration in original.]

The car used in this arrangement has the door openings 39 (left hand occurrence) and 40 in the opposite sidewalls offset longitudinally so that each sidewall includes a long wall section and a short wall section on opposite sides of the opening. Side filler panels 43 and 45 are affixed to the interiors of the [*1394] long wall sections 37 and 34, respectively, and longitudinally adjustable bulkheads 47 and 48 are provided. [*1312] The car is shown completely filled with groups of pelletized containers 51 and 52, secured in position by the side filler panels and bulkheads. The [***3] application describes the loading of this car as follows:

Typically, the load dividers 47 and 48 are initially moved to the left of doorway 40 to permit free access to the floor surface area in the "deep end" of the car bounded by end wall 30. The pallets 51 are placed into the car in sequence, adjusting the side fillers to the necessary width required to firmly confine the pallets in place. During this time, door 49 is already closed to form the lateral support for the six pallet stacks 51 nearest load divider 48. The load divider 48 is then moved into position against the stacked pallets 51 and locked in place. The second load divider 47 is then temporarily positioned closely adjacent load divider 48 to permit free access to the "short end" of the car terminated by end wall 31. Pallets 52 are then sequentially placed in position, adjusting the side fillers 45 to retain these pallets against lateral shifting. The three side fillers in the series 45 which are closest to the load divider 47 are preadjusted prior to loading the six pallet stacks 52 nearest load divider 47. Finally, load divider 47 is moved into tight engagement with the stacked pallets 52, locked in place, and [***4] the door 50 is closed to secure the pallets 52.

The only independent claim on appeal is claim 13 which we reproduce as follows:

13. An improved car-loading construction for use in elongated, wall-enclosed railway cars of the type utilizing therein longitudinally movable load-confining transverse bulkheads which are adapted to be located generally centrally of the ends of the car to project across substantially the entire width of the car;

said improved car-loading construction comprising, in combination,

the longitudinal side walls of the car each having a single doorway therein located between the ends of the wall to divide the wall into spaced long and short sections,

the doorways being offset toward different ends of the car so that the major portion of each doorway is directly opposite the long wall section of the opposing side wall, and

side filling panels mounted on the inside surface of each of said long wall sections and being adjustable toward and away from the corresponding long wall section, so that the transversely adjustable side filling panels on one long wall section and a longitudinally adjustable transverse bulkhead may cooperate to substantially fully [***5] enclose the load in one end of the car substantially to the mid-point of the car without adversely affecting the ability to load the other end of the car.

Claim 14 adds the additional limitations that the car is adapted to carry pallet-mounted loads and the lengths of the side walls of the car conform substantially to whole multiples of a dimension of a pallet. Claim 15 further provides that the portion of each doorway directly opposite a wall is "substantially equal to a plural multiple of a dimension of the pallet" and that the rest of the doorway is narrower than a pallet dimension.

[*1313] The Rejection

Claims 13, 14 and 15 were rejected as unpatentable over Cook n2 in view of either Robertson n3 and Aquino n4 or of Lundvall, n5 under 35 USC 103.

n2 Patent No. 2,930,332, granted March 29, 1960.

n3 Patent No. 3,212,458, granted October 19, 1965.

n4 Patent No. 3,217,664, granted November 16, 1965.

n5 Patent No. 3,163,130, granted December 29, 1964.

Cook discloses a railway box car having sides defining oversized door openings [*1395] in diagonally opposite ends of the car. That construction is described as facilitating loading and unloading lumber, [***6] permitting it to be palletized and to be handled by lift trucks.

Lundvall discloses a railway car provided with adjustable side filler panels for preventing lateral shifting of the load and adjustable bulkheads to hold the load against longitudinal shifting.

Robertson discloses a specific side filler panel construction for railway cars and Aquino is directed to a bulkhead construction for similar use.

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The examiner and board based their holdings that the appealed claims are unpatentable on the view that persons of ordinary skill in the art would find it obvious to use bulkheads and side filler panels, as disclosed in the secondary references, in connection with loads placed in a car of the Cook construction.

Opinion

Appellant has strenuously urged that the reference disclosures were improperly combined. In particular, with regard to Cook, he argues that, while the reference does show elongated, longitudinally offset doors, it does not suggest such an arrangement in combination with a bulkhead and side fillers because of the patentee's expressed desire to have a car capable of being loaded and unloaded simultaneously from both sides, which is not the desire of appellant [***7] nor even possible, he urges, with his arrangement.

[1] We have taken the above argument into consideration and do find that it has some merit. Nevertheless, it is not convincing. It should be too well settled now to require citation or discussion that the test for combining references is not what the individual references themselves suggest but rather what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the [2] art. Any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made and does not include knowledge [*1314] gleaned only from applicant's disclosure, such a reconstruction is proper. The Cook patent does indicate that the car shown therein is suitable for carrying palletized loads with lift trucks being used for the loading and unloading, including stacking of the pallets. Since the secondary references show that it was well known to use side filler panels and bulkheads to confine palletized loads to prevent lateral and longitudinal shifting, [***8] we agree that those references would have suggested use of such panels and bulkheads with the Cook car for the same purpose.

[3] The foregoing conclusion in itself, however, is not determinative of the present appeal. Appellant has submitted evidence tending to prove that his invention has solved the long-standing problem of utilizing the maximum amount of space in standard, 50-ft. boxcars, permitting loading the car with 56 pallets of 48" X 40", whereas prior to the invention, cars of that size could be loaded with only 46 such pallets properly confined. The evidence, comprising two affidavits and a series of exhibits, indicates that the invention has been commercially successful and that its concept was promptly adapted by a competitor. Recognizing that the

inference of obviousness drawn from the prior art disclosures is only prima facie justification for drawing the ultimate legal conclusion that the claimed invention is unpatentable under 35 USC 103, it is imperative that such secondary considerations also be evaluated in determining the final validity of that legal conclusion. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). We emphasize that such is true even [***9] where, as here, the claimed invention involves only relatively simple mechanical concepts. As we have said on another occasion: "A patentable invention, [***1396] within the ambit of 35 USC 103, may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use." *In re Spornoble*, 56 CCPA 823, 405 F.2d 578, 160 USPQ 237 (1969).

The first affidavit was by appellant, himself, the manager of the Customer Relations Department of the Equipco division of Unarco Industries, Inc., the assignee of the application. He asserts that 355 railway cars equipped for use with his invention, valued at nearly eight million dollars, were ordered within little more than a year. Included with this affidavit are a series of reproductions of trade journal articles and advertisements tending to support the further assertion made in the affidavit, that the problem of effectively utilizing space was a familiar one. One exhibit is a copy of the advertisement of a competitor, tending to indicate that appellant's concept was adopted by that competitor. The other affidavit is by John Clement, [***10] general [***1315] traffic manager with the Corn Products Co. and apparently a disinterested third party. The affiant states that he has the duty of obtaining all the railroad and other types of cargo equipment necessary for shipping the company's products and that he became interested in the invention immediately upon its being disclosed to him because it appeared to solve problems presented by prior railway car arrangements, allowing use of substantially the entire cargo carrying capacity of the car while permitting truck loading. The affidavit further states that Corn Products had already received 10 cars possessing the proposed arrangement, had ordered 11 more and was negotiating for an additional forty.

The examiner did not consider the affidavits persuasive. That of Clement he characterized as alleging that appellant's arrangement is more versatile than prior arrangements without advancing any factual support. He regarded appellant's own affidavit as lacking sufficient facts to show that the asserted commercial success resulted from the invention as claimed. The board did not comment on either affidavit in its opinion.

Our own consideration of the affidavits in light [***11] of appellant's arguments convinces us that there

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was a problem in the art due to floor space in the mid-section of cars with side doorways not ordinarily being usable for palletted goods which require securing against transverse and lateral shifting. Moreover, the favorable opinion Clement expressed of the invention and the showing of extensive purchases of equipment for utilizing it indicate that appellant provided an unobvious solution of the problem. The affidavits reveal the solution as involving the arrangement substantially as described in applicant's application. Thus an arrangement is required wherein the relationship of the dimensions of the long and short wall sections and the door opening of the car are such that the pallets may be machine-loaded substantially to its full capacity. We note that these features are brought out fully only in claim 15 which recites that the long and short sections of the side walls are substantially equal to whole multiples of a dimension of a pallet and that the portions of the

doorway directly opposite each other have a width equal to a plural multiple of a dimension of a pallet. As to that claim, we find appellant's secondary evidence [***12] adequate to rebut the initial inference of obviousness, and, accordingly, reverse the decision of the board.

On the other hand, the affidavit showings do not demonstrate that an arrangement lacking any of the characteristics defined in claim 15 solved the previous space-utilization problem or that the commercial [*1316] success was due to less than all of those features. As to claims 13 and 14, thus, the prima facie case of obviousness made out by the prior art stands un rebutted and the board's decision [**1397] pertaining thereto must be sustained.

The decision of the board is affirmed as to claims 13 and 14 and reversed as to claim 15.